UNITED STATES PATENT AND TRADEMARK OFFICE

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09/285,249	04/02/1999	JOHN S. HENDRICKS	5200	3419

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EXAMINER
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ART UNIT	PAPER NUMBER
2611	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

Office Action Summary	Application No. 09/285,249	Applicant(s) HENDRICKS ET AL.
	Examiner Christopher Grant	Art Unit 2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 June 2003* .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21,23 and 24* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21,23 and 24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____ .

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *12* .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: .

DETAILED ACTION

Specification

1.   The amendment filed 5/28/2003 is objected to under 35 U.S.C. 132 because it introduces

new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new

matter into the disclosure of the invention. The added material which is not supported by the

original disclosure is as follows:

Applicant's deletion of the word "not" in the paragraph being replaced at page 26, line 14

is new matter. There is no support from the originally filed disclosure for the replacement

paragraph.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

3.   Claims 1-21 and 23-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the written description requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to reasonably convey to one skilled in the

relevant art that the inventor(s), at the time the application was filed, had possession of the

claimed invention.

The disclosure fails to support the following limitations now recited in claims 1 and 9:

"an authorization component, connected to said network manager..., to transmit a first
authorization code to enable set top terminals to receive a requested program";
a file server, coupled to said network manager, capable of receiving said first authorization
code, and a second authorization code, wherein the requested program is scrambled...".

The specification (at page 27, lines 1-4) describes that the first authorization code is sent
from component 236 to the file server 215 (both at the headend) to enable the set top terminal to
tune to a **specific preview channel**.   Note that the specification **does not** indicate that the set top
terminal is enabled to receive **the requested program** as required by claims 1 and 9.

The specification (at page 15, lines 11-17) describes that the second authorization code is
sent to the set top terminal by the file server 215 to descramble a scrambled program. Therefore,
the file server **does not receive the second authorization code**. Instead, the file server transmits
the second authorization code to the set top terminal.

The disclosure fails to support the following limitations now recited in claims 17 and 10:
"a file server...capable of receiving a first authorization code to enable... set top terminals
to receive a requested program, and a second authorization code, wherein the requested
program is scrambled...".

The specification (at page 27, lines 1-4) describes that the first authorization code is sent
from component 236 to the file server 215 (both at the headend) to enable the set top terminal to
tune to a **specific preview channel**.   Note that the specification **does not** indicate that the set top
terminal is enabled to receive **the requested program** as required by claims 10 and 17.

The specification (at page 15, lines 11-17) describes that the second authorization code is sent to the set top terminal by the file server 215 to descramble a scrambled program. Therefore, the file server **does not receive the second authorization code**. Instead, the file server transmits the second authorization code to the set top terminal.

The disclosure fails to support the following limitations now recited in claim 20:

"*c) sending a first authorization code to a file server to enable set top terminal to receive a requested program;*

d) spooling...server;

e) authorizing viewing or delivering of said requested program; and

f) downloading a second authorization code when the requested program is scrambled, wherein the second authorization code descrambles said scrambled requested program".

The specification (at page 27, lines 1-4) describes that the first authorization code is sent from component 236 to the file server 215 (both at the headend) to enable the set top terminal to tune to a **specific preview channel**. Note that the specification **does not** indicate that the set top terminal is enabled to receive **the requested program** as required by claim 20.

The disclosure fails to support the following limitations now recited in claim 25:

"*c) sending a first authorization code to a file server;*

d) spooling said requested program from said file.server;

e) authorizing viewing or delivering of said requested program;

The specification (at page 27, lines 1-4) describes that the first authorization code is sent from component 236 to the file server 215 (both at the headend) to enable the set top terminal to tune to a **specific preview channel**. Note that the specification **does not** indicate that the set top terminal is enabled to receive **the requested program** as required by claim 25.

The specification (at page 27, lines 1-4) relates to the embodiment of figure 6.

The specification, at page 26, lines 14-19, (relating to figure 6 embodiment) describes that the (second) authorization code is sent to the set top terminal by the headend, if the set top terminal receives the program in scrambled format.

The specification at page 15, lines 11-22 (another embodiment relating to figure 2) describes that the authorization component (236) processes subscriber requests and prompts the file server (215) to spool the requested program and **alternatively** "the file server (215) may be instructed to transmit an authorization code to the subscriber to enable descrambling or reception of a specific program...". Therefore, the specification **does not** support the steps of providing first **and** second authorization codes to enable a set top terminal to receive a requested program as required by the claims. Rather, the specification describes the authorization component **processes** the subscriber request to spool the requested program **or** transmit an authorization code for descrambling. Furthermore, it is not clear if Applicant is combining the embodiment of figure 2 with the embodiment of figure 6.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5.   Claims 1-21 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Wunderlich et al. (Wunderlich) in view of Farry et al. (Farry) and further in view of Block et al.

(Block).

Considering claim 1, Wunderlich discloses an apparatus for video on demand programs

comprising:

a) a receiver (51) to receive requests for video on demand programs (col. 9, lines 1-3);

b) a network manager (51) to process said program request (col. 9, lines 4-14);

c) a file server (52), coupled to the network manager (51), wherein the file server spools the

requested program via device (53).

Although Wunderlich discloses authorizing the subscriber to view the requested program

(col. 9, lines 15-20 and 23-26), he fails to specifically disclose an authorization component to

transmit a first authorization code to enable set top terminals to receive a requested program and

a second authorization code to descramble a scrambled program as recited in the claims.

Farry discloses an apparatus (figure 16) for video on demand programs comprising an

authorization component (1670 and/or 501) that transmits a notification signal (e.g. an

authorization code or identification) to a level 1 gateway server (1640) for the advantage of

authorizing service to a subscriber. See column 11, lines 1-35.

Block discloses transmitting scrambled programs from a headend to set top terminals and transmitting authorization codes from the headend to set top terminals for descrambling the scrambled programs. See the entire reference including but not limited to col. 3, lines 38-49, col. 4, lines 20-36 and col. 2, lines 58-63.

It would have been obvious to one of ordinary skill in the art to modify Wunderlich's system (if necessary) to include an authorization component to transmit an authorization code to enable set top terminals to receive a requested program, as taught by Farry, for the typical advantage authorizing service to a subscriber.

Furthermore, it would have been obvious to one of ordinary skill in the art to modify the combined systems of Wunderlich and Farry to include a second authorization code to descramble a scrambled program, as taught by Block, for the additional advantage of descrambling scrambled programs received by set top terminals to prevent theft of program signals.

Claim 2 is met by the combined systems of Wunderlich, Farry and Block, wherein Wunderlich discloses a network manager (51) that comprises a processor inherently having an instruction memory for executing the processing of the program request as described at col. 9, lines 4-14.

Claim 3 is met by the combined systems of Wunderlich, Farry and Block, wherein Wunderlich discloses a network manager (51) that comprises a processor having control software that compile the program requests to determine if a channel is available for a requesting subscriber as described in col. 9, lines 15-25.

Claims 4-5 are met by the combined systems of Wunderlich, Farry and Block, wherein

Wunderlich discloses that file server deliver at least one requested program to the requesting

subscriber.

Claim 6 is met by the combined systems of Wunderlich, Farry and Block, wherein

Wunderlich discloses that programs are stored in MPEG format at col. 7, lines 60-65.

Claim 7 is met by the combined systems of Wunderlich, Farry and Block, wherein

Wunderlich discloses that the request for VOD programs are from set top terminals (14)

described throughout the reference including but not limited to col. 5, lines 15-20 and col. 9,

lines 1-40.

Claim 8 is met by the combined systems of Wunderlich, Farry and Block because the

transferring of any signal (including an authorization code) between two equipments has to

include an interface device. For example, a printer interface card is necessary in a computer to

send data to the printer and an interface is needed in a computer in order to receive input data

from a keyboard. Therefore, one of ordinary skill in the art would readily recognize that in

interface is a necessary device in the transfer of data between equipments.

Claim 9 is met by the combined systems of Wunderlich, Farry and Block as described in

the rejections of claims 3 and 8.

Claims 10 and 17 are met by the combined systems of Wunderlich and Farry as described

in the rejections of claims 3 and 8, since Farry's authorization component (501) has to receive a

request in order to issue authorization.

Claim 11 is met by the combined systems of Wunderlich, Farry and Block, wherein

Wunderlich discloses a network manager (51) that comprises a processor inherently having an

instruction memory for executing the processing of the program request as described at col. 9,

lines 4-14.

Claim 12 is met by the combined systems of Wunderlich, Farry and Block, wherein

Wunderlich discloses a network manager (51) that comprises a processor having control software

that compile the program requesfs to determine if a channel is available for a requesting

subscriber as described in col. 9, lines 15-25.

Claim 13 is met by the combined systems of Wunderlich, Farry and Block, wherein

Wunderlich discloses that the request for VOD programs are from set top terminals (14)

described through out the reference including but not limited to col. 5, lines 15-20 and col. 9,

lines 1-40.

Claims 14-15 are met by the combined systems of Wunderlich, Farry and Block, wherein Wunderlich discloses that file server deliver at least one requested program to the requesting subscriber.

Claims 16 and 18-19 are met by the combined systems of Wunderlich, Farry and Block, wherein Wunderlich discloses that programs are stored in MPEG format at col. 7, lines 60-65. Note that MPEG programs are digital programs.

Claim 20 is met by the combined systems of Wunderlich, Farry and Block as described in the rejection of claim 1. In particular, the claimed "e) authorizing viewing or delivering of the requested program" is met by the first and/or the second authorization codes and the claimed "f) downloading a second authorization code...." is met by the authorization code taught by Block.

As for claim 23, the combined systems of Wunderlich, Farry and Block fail to specifically disclose authorizing viewing of previews as recited in the claim. However, the Examiner takes Official Notice that it is well known in the art to authorize viewing of plural types of program content including but not limited to movies, music, text, graphics, data and short clips (i.e. previews). It would have been obvious to one of ordinary skill in the art to modify the combined systems of Wunderlich, Farry and Block (if necessary) to include authorizing viewing of any type of program content such as previews for the typical advantage of permitting a certain set of customers to view specific content.

As for claims 21, 24 and 25, the combined systems of Wunderlich, Farry and Block disclose all the claimed subject matter above, except counting a period of time, receiving additional requests, authorizing viewing and or delivering the requested program after the period of time expires as recited in the claims.

However, the Examiner takes Official Notice that it is well known in video-on-demand (VOD) or store- and-forward systems for the headend to track or log the number of program requests for the typical advantage of providing headend system housekeeping including offering a grace period (such as 5 minutes) to allow a predetermined number of requests to be received by the headend to conserve system resources. That is, video-on-demand systems typically require assigning a channel for each program requested. Assigning plural requesting subscribers to a single channel would conserve system resources thereby limiting the possibility of using all of the system resources.

It would have been obvious to one of ordinary skill in the art to modify the combined systems of Wunderlich, Farry and Block to include counting a period of time, receiving additional requests and authorizing viewing and or delivering of the requested program after the period of time expires, for the typical advantage of providing headend system housekeeping by offering a grace period (such as 5 minutes) to allow a predetermined number of requests to be received by the headend so that one channel can serve plural requesting subscribers instead of one requesting subscriber.

Response to Arguments

6.   Applicant's arguments filed 5/28/2003 with respect to 35 USC 112 issues have been fully

considered but they are not persuasive.

a)   Applicant argues (at page 7, first paragraph of the amendment) that "**The specification is**

amended to correct an obvious typographical error..." and that specification at page 15, lines

11-17 support's the deletion of the word "not" in the specification at paragraph at page 26, line

14.

        (Response) First, the Examiner disagrees that the amendment corrects an obvious

typographical error. Applicant is deleting an entire word that affects the scope of the disclosure.

        Secondly, the paragraph at page 15, lines 11-17, provides support for the file server

spooling a program requested by the subscriber **or** sending authorization code to the subscriber

to enable descrambling or reception. The Examiner cannot determine if page 15, lines 11-17

support the deletion of the word "not" in the paragraph beginning at page 26, line 14, since a

scrambled or a descrambled program may be spooled to a subscriber.

        Thirdly, the paragraph at page 15, lines 11-17 relates to the embodiment of figure 2 while

the paragraph at beginning at page 26, line 14 relates to the embodiment of figure 6. It is not

clear if Applicant's instant invention relates to figure 2 or to figure 6.

        For the reasons given above, the Examiner contends that deletion of the word "not" is

new matter and it must be put back into the specification.

b) Applicant argues that the 112 rejections of claims 20-21 and 23-25 are improper on page 8, lines 1-14 of the amendment provided 5/28/2003.

In response the examiner totally disagrees with Applicant. Applicant should note that claim 20 recites "*c) sending a first authorization code to a file server to enable set top terminal to receive a requested program*" (lines 5-6) and "*f) downloading a second authorization code when the requested program is scrambled*" (line 9).

The first authorization code according to Applicant is supported by the specification at page 27, lines 1-4. The first authorization code is sent from component 236 to the file server 215 (both at the headend) to enable the set top terminal to tune to a **specific preview channel** **not** the requested program.

The second authorization code according to Applicant is supported by the specification at page 26, lines 14-19. The second authorization code is sent to the set top terminal to descramble a scrambled program.

Therefore, the specification does not provide support for "*c) sending a first authorization code to a file server to enable set top terminal to receive a requested program.*

Moreover, the embodiment of figure 6 provides

For the reasons given above, the Examiner posits that Applicant's arguments are not persuasive.

7.   Applicant's arguments with respect to claims 1-21 and 23-25 over Wunderlich and Ferry have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8.   The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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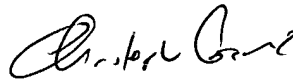Typed or printed name of person signing this certificate:

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Signature: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Christopher Grant whose telephone number is (703) 305 4755.

The examiner can normally be reached on Monday-Friday 8:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone numbers for the

organization where this application or proceeding is assigned are (703) 872 9314 for regular

communications and (703) 872 9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 305-4700.

Christopher Grant
Primary Examiner
Art Unit 2611

CG
August 10, 2003